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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,904	11/27/2001	Jax B. Cowden	10005.000130	7663

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EXAMINER

DIVECHA, KAMAL B

ART UNIT PAPER NUMBER

2151

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/993,904

Applicant(s)

COWDEN ET AL.

Examiner

KAMAL B. DIVECHA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**Response to Arguments**

Claims 1, 2, 4-7 are pending in this application.

Applicant's arguments filed in an appeal brief, on March 6, 2006, with respect to claims 1, 2, 4-7 have been fully considered. All previous rejections of claims 1, 2, 4-7 has been withdrawn and a non-final action has been issued accordingly.

**Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1, 2, 4-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 discloses a method to be performed by code or program does not fall into any of the four categories of the statutory subject matter as set forth above.

The claim is simply directed to a computer program, which does not produce useful, concrete and tangible results.

A human being using pen and paper can simply conduct the steps involved in claim 1.

For more information regarding the 35 USC 101 common practice, law and office policies, please see the 101 guidelines available on the USPTO web site.

2. Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

Claim fails to disclose the practical application and/or the utility. In other words, claim fails to disclose the problem to be solved and/or the utility of the invention.

Claim also fails to produce any useful, concrete and tangible results.

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For more information regarding the 35 USC 101 and the office policies, please see the 101 guidelines available on the USPTO web site.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is considered indefinite because the preamble of the claim does not support the body of the claim i.e. Preamble describes a method for providing product information to a user whereas the body of the claim describes the process of offering a computer program.

Claims simply fail to disclose the practical application, i.e. a utility.

Please Note: computer program is not considered a product unless it is tangibly embodied (see the 35 USC 101 rejection).

Dependent claims 2 and 4-6 are rejected due to their dependency on claim 1.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 2, 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawcett (U. S. Patent No. 6,327,617 B1) in view of Slotznick (U. S. Patent No. 6,011,537).

As per claim 1, Fawcett discloses a method of providing product information to a user, the method to be performed by computer-readable program code running in a computer, the method comprising: determining if the first window includes offer to download a computer program (col. 10 L25-35); identifying the computer program (col. 6 L29-49, col. 8 L43-59, col. 11 L27-60); and displaying a second window in the computer, the second window including third party information about the computer program (col. 10 L53-64), however Fawcett does not disclose the process of detecting an occurrence of a first window in the computer.

Slotznick, from the same field of endeavor discloses the process of delivering and displaying information in form of a window or a frame (see abstract, col. 6 L15-41, col. 15 L1-31). In one embodiment, Slotznick discloses the process of detecting an occurrence of a first window in the computer (col. 20 L40-50, col. 20 L51 to col. 21 L19, col. 23 L55-67, col. 40 L11-65).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Fawcett in view of Slotznick in order to detect a window in the computer, since Slotznick teaches the process of detecting the occurrence of the windows in the computer.

One of ordinary skilled in the art would have been motivated so that the information is displayed to the user (Slotznick, col. 20 L50 to col. 21 L11).

As per claim 2, Slotznick discloses the process wherein the first window is launched by a web browser (col. 37 L13-57).

As per claim 4, Fawcett discloses the process wherein the act of identifying the computer program includes looking up a class identification (simply interpreted as version number) of the computer program (col. 6 L29-49).

As per claim 5, Fawcett discloses the process wherein the act of identifying the computer program includes consulting a product list (col. 8 L42-64, col. 11 L46-60).

As per claim 6, Fawcett discloses the process wherein the product list is updateable by downloading a new product list from a remote computer to the computer (col. 5 L15-45).

As per claim 7, Fawcett discloses a computer memory comprising: a product list, the product list including a list of computer programs and a description of each of the computer

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programs (col. 8 L43-64, col. 11 L27-60), the description of each of the computer programs comprising third-party information that helps users decide whether they should install a computer program being offered for download (col. 10 L42-64, col. 5 L54-64); a window analyzer, the window analyzer including a code for detecting whether the new window is offering a computer program listed in the product list for download (col. 10 L25-43); a user interface manager, the user interface manager including computer-readable program code for displaying third party information about the computer program offered in the new window and listed in the product list (col. 10 L53-64), however Fawcett does not disclose a listener for detecting the opening of a new window in the computer.

Slotznick, from the same field of endeavor discloses the process of delivering and displaying information in form of a window or a frame (see abstract, col. 6 L15-41, col. 15 L1-31). In one embodiment, Slotznick discloses the process of detecting an occurrence of a first window in the computer (col. 20 L40-50, col. 20 L51 to col. 21 L19, col. 23 L55-67, col. 40 L11-65).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Fawcett in view of Slotznick in order to detect a window in the computer, since Slotznick teaches the process of detecting the occurrence of the windows in the computer.

One of ordinary skilled in the art would have been motivated for the same reasons as set forth in claim 1.

**Additional References**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Ronning, U. S. Patent No. 5,883,955: ON-LINE TRY BEFORE YOU BUY SOFTWARE DISTRIBUTION SYSTEM.
- b. Rose, U. S. Patent No. 5,708,709: System and Method for MANAGING TRY-AND-BUY USAGE OF APPLICATION PROGRAMS.




**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Kamal Divecha  
Art Unit 2151  
May 23, 2006.

  
ZARNI MAUNG  
SUPERVISORY PATENT EXAMINER